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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Kovesdi et al.

Confirmation No.: 3522

Serial No.: 10/035,952

Art Unit: 2876

Filed: December 26, 2001

Examiner: K. Koyama

For: SYSTEM AND METHOD FOR
AUTHORING AND PROVIDING
INFORMATION RELEVANT TO
A PHYSICAL WORLD

Attorney Docket No.: 802959-999002

RECEIVED

APR 19 2004

OFFICE OF PETITIONS

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(A),
FOR REMOVAL OF A JOINT SIGNATURE REQUIREMENT AND ENTRY OF A
PREVIOUSLY SUBMITTED RESPONSE TO OFFICE ACTION, AND FOR
SUSPENSION OF PROSECUTION UNDER 37 C.F.R. § 1.183**

Commissioner for Patents
P. O. Box 1450
Alexandria, Va 20231

Dear Sir:

Inventor Rozsa Kovesdi respectfully requests the Commissioner to grant this application a 37 C.F.R. § 1.47(a) status, or in the alternative to remove the joint signature requirement currently in place and to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. In particular, it is respectfully requested that a response to the outstanding Office Action, which representatives of Ms. Kovesdi filed on September 18, 2003 be entered without the signature of co-inventor Rajasekharan. Unless the requested relief is granted, the application would likely become abandoned, causing irreparable harm to her interests in the inventions claimed therein, and would leave her with no opportunity to request the Patent Office to resolve the disputed inventorship. To prevent this application from going abandoned before the Patent Office can rule on the instant submission, petitioner Kovesdi urgently requests the Commissioner to suspend its prosecution under 37 C.F.R. § 1.103.

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The core issue to be resolved is whether petitioner Kovesdi is entitled to seek an opportunity to have a potential inventorship dispute between her and Mr. Rajasekharan resolved by the Patent Office. The underlying facts are simple: in July 2001 Ms. Kovesdi and Mr. Rajasekharan filed a provisional application naming both as inventors. In November 2001, Mr. Rajasekharan filed a non-provisional application that claims priority from the joint provisional application but lists him as the sole inventor (the '597 application). Ms. Kovesdi filed the present application (the '952 application) in December 2001 also claiming priority of the joint provisional application and listing both herself and Mr. Rajasekharan as co-inventors. As efforts to agree on a joined prosecution of the '952 application failed, Ms. Kovesdi filed a petition under 37 C.F.R. § 1.47(a) to prosecute the application on behalf of both inventors. Subsequently, Mr. Rajasekharan petitioned to join in the '952 application, expressly stating that he is the sole inventor "of a substantial number of the presented claims including all independent claims." Mr. Rajasekharan's petition further requested the Patent Office to require both parties to sign all subsequent replies under MPEP § 402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources."

Despite the fact that Mr. Rajasekharan's request appears to violate MPEP § 409.03(i) which directs a party asserting sole inventorship of claims in a joint application to resolve the issue in a different patent application, the Patent Office denied Ms. Kovesdi's § 1.47(a) petition, granted Mr. Rajasekharan's petition to join, and imposed a requirement that all subsequent papers in this application be signed by both parties. By contrast, the Patent Office denied Ms. Kovesdi's petition to join in the '597 application as a co-inventor, allegedly because she was not a "proper party in interest." This determination was not based on the merits of her request to join, but solely on the fact that the originally filed declaration in the '597 application did not list Ms. Kovesdi as a co-inventor.

As a result of the above procedures, Ms. Kovesdi was placed in the anomalous position of not having even an opportunity to present for resolution to the Patent Office any potential issues of inventorship, because her co-inventor effectively has a veto power over any submission to the Patent Office. Indeed, the prosecution of the '952 application before the Patent Office has demonstrated that Mr. Rajasekharan's previous statement that a joint signature requirement would "encourage the parties to work out a jointly submitted

amendment" simply meant that Ms. Kovesdi would have no choice, and based solely on his own allegations Mr. Rajasekharan could resolve any issue in his favor.

In particular, in response to a rejection of the claims in the '952 application, Mr. Rajasekharan has taken the position that only two out of 107 claims in this application were jointly invented, and has refused to sign any response that does not involve the cancellation of the remaining claims in favor of prosecuting the claimed subject matter in his own '597 application. Mr. Rajasekharan has taken this position despite the fact that he has acknowledged in writing that a substantive response addressing all claims in the application and prepared by Ms. Kovesdi's representatives is technically accurate. The Patent Office did not enter Ms. Kovesdi's response because it did not have the signatures of both inventors. At present, facing a new deadline to respond to the same Office Action, Ms. Kovesdi's options appear to be: letting the application go abandoned (and irreparably damaging her interest in the subject matter claimed therein), or canceling virtually all claims in the application and expressly acknowledging Mr. Rajasekharan's alleged sole inventorship.

The above alternatives are testament of what can go wrong if the Patent Office's rules of practice are applied inconsistently or fail to take into account the equities in a case. These rules of practice are intended to protect the rights of the parties and the fairness of the process, not to unfairly treat one party for the benefit of another. Accordingly, in view of the Mr. Rajasekharan's refusal to cooperate in the prosecution of this application, and to protect the interests of Ms. Kovesdi as an innocent co-inventor risking a complete loss of rights through no fault of her own, it is respectfully requested that the '952 application be granted 37 C.F.R. § 1.47(a) status and/or that the joint signature requirement be removed, allowing Ms. Kovesdi's previously filed response to be entered. To prevent this '952 application from going abandoned, it is respectfully requested that its prosecution be suspended under 37 C.F.R. § 1.103.

STATEMENT OF FACTS

1. Petitioner Rozsa Kovesdi filed the present application, Serial No. 10/035,952 (the '952 application) on December 26, 2001, claiming priority of provisional application Ser. No. 60/306,356, filed July 18, 2001 (the '356 application). In a declaration to the Patent Office Ms. Kovesdi listed herself and Mr. Ajit Rajasekharan as co-inventors of the '952

application; the same two are listed as co-inventors of the provisional '356 application, which has identical disclosure and claims. (Exh. A).

2. After attempts to reach out to Mr. Rajasekharan failed, on May 1, 2002 Ms. Kovesdi's filed a petition under 37 C.F.R. § 1.47(a) asking to prosecute the application on behalf of herself and the non-signing inventor. (Exh. B).

3. On June 4, 2002 Mr. Rajasekharan filed a petition under 37 C.F.R. § 1.182 in the '952 application, asking for appointment of a power of attorney by less than all applicants. The petition stated that Mr. Rajasekharan desires his own representation to prosecute the '952 application, because he is the sole inventor "of a substantial number of the presented claims including all independent claims," and that "a portion of the solely conceived claims are being prosecuted in a copending U.S. utility patent application" naming him as the sole inventor. Mr. Rajasekharan's June 4 petition also requested that both parties be required to sign all subsequent replies under MPEP §402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources." (Exh. C, p.2).

4. The Patent Office dismissed Mr. Rajasekharan's June 4 petition, because the declaration filed along with this petition omitted Ms. Kovesdi as an inventor. In the same document the Patent Office invited Mr. Rajasekharan to consider filing his own application in case he believed the inventorship of the '952 application to be in error. (Exh. D).

5. On August 23, 2002, Mr. Rajasekharan filed a second, substantially similar petition under 37 C.F.R. § 1.182, which included a newly executed declaration, listing both himself and Ms. Kovesdi as co-inventors of the '952 application. (Exh. E).

6. On September 17, 2002, the Patent Office granted Mr. Rajasekharan's second 37 C.F.R. § 1.182 petition, dismissed Ms. Kovesdi's 37 C.F.R. § 1.47(a) petition, and imposed a requirement that all further correspondence be signed by representatives of both parties. (Exh. F).

7. The first Office Action in the '952 application, issued on March 18, 2003, rejecting all pending claims of the application. (Exh. G).

8. Mr. Rajasekharan provided a draft response to the Office Action on May 21, 2003, proposing to cancel all pending claims except dependent claims 43 and 44, and to include a statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. (Exh. H, p.3). This draft response is the first time Mr. Rajasekharan stated his contentions concerning the inventorship of the claims in the '952 application, and included no support for these contentions.

9. Ms. Kovesdi's representatives drafted a separate response addressing all pending claims and provided this draft response to Mr. Rajasekharan for review and signature on September 15, 2003. (Exh. I).

10. On September 17, 2003 representatives of both parties discussed the response proposed by Ms. Kovesdi on the phone, and agreed that the response was not objectionable. On that basis, and to prevent the application from going abandoned for failure to respond, Ms. Kovesdi's representatives filed in the Patent Office the discussed response, although it was not signed by both parties. (Exh. J).

11. On September 22, 2003 Mr. Rajasekharan's representatives sent a letter insisting that their draft of the response should be filed, stating that "[a]lthough we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70." (Exh. K). Ms. Kovesdi's representatives filed on the same day a supplemental response to the Office Action, including a copy of the September 22 letter, and asked the Patent Office to accept it in lieu of Mr. Rajasekharan's signature. (part of Exh. K).

12. On December 16, 2003, the Patent Office issued an Office Action, stating that while the September 18 and 22, 2003 reply "appears to be *bona fide*," it lacked the signatures of both parties. The examiner gave applicants one month to correct. (Exh. L).

13. Representatives of Ms. Kovesdi have been unable to obtain Mr. Rajasekharan's signature, despite diligent efforts. In particular, following the December 16, 2003 Office Action, representatives of Ms. Kovesdi unsuccessfully requested Mr. Rajasekharan in letters dated January 6, 2004 and April 1, 2004 respectively and in other

communications, to sign the admittedly correct response they have prepared to the Office Action in the '952 application. (Exh. M).

14. On January 12, 2004, the Patent Office rejected Ms. Kovesdi's petition to join as a co-inventor in Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. The rejection is on the ground that she is not a "proper party in interest" apparently because she was not listed on the first executed declaration in this application. The Patent Office expressly stated that it did not consider the petition to join as a co-inventor on the merits. (Exh. N).

15. In March and early April 2004, representatives of both parties communicated again on issues related to the contested inventorship but were unable to reach an agreement. In particular, in a letter of April 8, 2004, Mr. Rajasekharan's representatives informed Ms. Kovesdi that the acceptable options in the '952 application are: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; and (3) sign a joint request for the filing of a continuation application. The April 8 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. O).

16. Unless a response to the Office Action dated December 16, 2003 is entered in the '952 application by June 16, 2004, the application will become abandoned.

ARGUMENT

1. Section 1.47 (a) Status Is Proper Because Mr. Rajasekharan Has Refused to Cooperate in the '952 Application

37 C.F.R. 1.47 (a) provides that if a "joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor." Although Mr. Rajasekharan was allowed to join in the '952 application, his refusal to cooperate on any substantive matter during its means that *de facto* Mr. Rajasekharan refuses to join in this application. Thus, for the reasons set forth below, Section 1.47 (a) status of the '952 application is warranted.

The facts in the prosecution of the '952 application unambiguously establish that after Mr. Rajasekharan was allowed to join in by decision of the Patent Office dated September 17, 2002 (Exh. F), he has consistently obstructed the prosecution of the '952 joint application in favor of his '597 application, in which he is listed as the sole inventor. Specifically, in response to a March 18, 2003 Office Action in the '952 application, Mr. Rajasekharan has asserted repeatedly that the only response acceptable to him is to cancel all but two claims in the application in favor of prosecuting the claimed subject matter in his '597 application. *See* response drafted by Mr. Rajasekharan's representatives dated May 21, 2003, which draft includes an express statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597 (Exh. H); *see also* subsequent correspondence in Exh. J, where commenting on an alternative draft response proposed by Ms. Kovesdi, Mr. Rajasekharan's representatives stated that they "find [the] technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case," but would not cooperate because prosecuting such claims in the joint application is against Mr. Rajasekharan's interests; *see also* Mr. Rajasekharan's letter of April 8, 2004 (Exh. O), which gives Ms. Kovesdi only three options in this case: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; or (3) sign a joint request for the filing of a continuation application. As noted, the April 8, 2004 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. O).

Clearly, unless Ms. Kovesdi agrees with his unilateral assertion of sole inventorship of virtually all claims, Mr. Rajasekharan is going to ensure that no substantive response can be filed. Ms. Kovesdi respectfully requests that the facts concerning the prosecution of the '952 application be accepted as proof of refusal under MPEP 409.03 (d).

The above facts are plainly inconsistent with Mr. Rajasekharan properly joining the '952 application, in fact they virtually define a joint inventor who "refuses to join in an application" and indicate that he may have "joined in" the '952 application simply to prevent its normal prosecution on the merits. Thus, inventor Kovesdi respectfully submits that granting a Section 1.47(a) status of the '952 application is necessary to protect her interests - holding otherwise would be contrary to the spirit the rules of patent practice and would be demonstrably inequitable.

Likewise, the joint signature requirement pursuant to MPEP 402.10, which applies in this case is intended to protect the interests of parties who have retained separate representation. Mr. Rajasekharan has refused to sign any joint responses to the Patent Office in the '952 application that do not involve canceling of all claims that he has unilaterally decided to be his own invention. His insistence that these claims be canceled unquestionably is injurious to Ms. Kovesdi's interests in the claimed subject matter, in favor of those of Mr. Rajasekharan, which are admittedly protected in a separate, '597 application. Mr. Rajasekharan's unilateral determination of the issues, based solely on its own allegations is undoubtedly wrong and contrary to Patent Office's rules and practice.

For the foregoing reasons, Ms. Kovesdi respectfully requests that she be allowed to prosecute the application on behalf of herself and Mr. Rajasekharan without the joint signature requirement.

2. The Decision to let Mr. Rajasekharan Join in the '952 Application Was In Error

The '952 application should be granted Section 1.47(a) status also because the Patent Office's September 17, 2002 decision allowing Mr. Rajasekharan to join in the application (Exh. F) was improper and violates MPEP 409.03 (i).

Mr. Rajasekharan's first and second Section 1.182 declarations filed on June 4 and August 23, 2002 respectively (Exh. C and Exh. E), included an express statement that he is the sole inventor of "a substantial number of claims including all independent claims." This declaration also included a statement that he has already filed a patent application (apparently the '597 application, which was not identified at the time) directed "to a portion of the solely conceived claims."

MPEP 409.03 (i) provides that "if a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, a nonsigning inventor may file his or her own application and request that he is or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared."

It is clear therefore, that the Patent Office erred in allowing Mr. Rajasekharan to join in this application, because the Patent Office was already on notice that he "feels that he is the sole inventor" and has already filed a separate application covering a portion of the "solely conceived claims." Ms. Kovesdi had no notice of the actual claims that appear in dispute until the April 8, 2004, when Mr. Rajasekharan confirmed which claims he considers his sole invention, and stated that unless Ms. Kovesdi agrees to "cooperate" with his unilateral decision, the joint '952 application will go abandoned or will be suspended until allowable subject matter is indicated in his '597 application. (Exh. O).

Accordingly, Ms. Kovesdi respectfully requests submits that Section 1.47(a) is warranted for the additional reason that the Patent Office's decision to allow Mr. Rajasekharan to join in the '952 application was in error.

3. Unless the Request is Granted, Ms. Kovesdi Will Suffer Irreparable Harm

Mr. Rajasekharan's April 8, 2004 letter (Exh. O) states that unless Ms. Kovesdi agrees to cancel the claims that he believes are his sole invention, "the application will become irrevocably abandoned." With a pending deadline to respond to an Office Action and a requirement that both co-inventors sign any such response (Exh. L), it is clear that the '952 application may be abandoned through no fault of Ms. Kovesdi's, unless the Patent Office intervenes without a delay. Abandonment without question will cause irreparable harm to Ms. Kovesdi's interests in the application and any inventions described therein.

Furthermore, the joint signature requirement in the '952 application effectively leaves Ms. Kovesdi with no possibility to raise the inventorship issue before the Patent Office. Mr. Rajasekharan's interests are protected in the co-pending '597 application that Ms. Kovesdi was not allowed to join. In contrast, Ms. Kovesdi cannot even raise the issue, because to do so in the '952 application would require Mr. Rajasekharan's consent. But in the very first submission made in this application (Exh. C) Mr. Rajasekharan has expressed his preference "to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources" - in other words, to avoid interference and prosecution by Ms. Kovesdi. Working out a joint solution is one thing, precluding the other party's choice in this matter, as appears to be Mr. Rajasekharan's intention in this application, is quite another. Removing even the opportunity to present any issue for resolution before

the Patent Office is clearly inequitable, it is contrary to the spirit and letter of the Patent Office's rules and practice and should not be allowed.

In addition, it has come to Ms. Kovesdi's attention that a second patent application, Ser. No. 10/103,777 (the '777 application) has been filed on March 25, 2002, as a continuation-in-part of the '597 application. The '777 application also does not list Ms. Kovesdi as an inventor although it appears that subject matter claimed in at least some claims of the application was contributed by her. Mr. Rajasekharan and Readia, the company that seems to be the assignee of his applications, have already put Ms. Kovesdi on notice that the "ground rules" for her to be considered as co-inventor in the '597 and '777 applications would involve her providing documentary support of all her contributions (apparently for review by Mr. Rajasekharan or Readia) (Exh. O).

Finally, under Federal Circuit precedent Ms. Kovesdi may also lose any potential interest in the patent or patents that may issue from the '597 application, because of the possibility that such patents may be declared unenforceable. *See, Frank's Casing Crew and Rental Tools, Inc. v. PMR Technologies, Ltd.*, 63 USPQ.2d 1065, 1069 (Fed. Cir. 2002) ("if unenforceable due to inequitable conduct, a patent may not be enforced even by innocent co-inventors.").

C nclusion

For the foregoing reasons, Ms. Kovesdi respectfully requests that the '952 application be granted a 37 C.F.R. § 1.47(a) status, or in the alternative that the Patent Office removes the joint signature requirement currently in place to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. No fee is believed due with this submission. Please charge any required fees to Jones Day Deposit Account No. 503013. A copy of this submission is also being served on the representatives of Mr. Rajasekharan.

Date April 16, 2004

Respectfully submitted,

for *Datta V. Shentov* *Regals 43,827*
Ognjan V. Shentov

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